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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,730

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Nicholas Dale

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EXAMINER

SAKELARIS, SALLY A

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

09/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,730	Applicant(s) DALE ET AL.	
	Examiner Sally A. Sakelaris	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-30 is/are rejected.
- 7) ☒ Claim(s) 26-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/6/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group II, claims 26-30 in the reply filed on 8/13/2009 is acknowledged. The traversal is on the ground(s) that the examiner related inventions I and II as product and process of using when they should have been related as process of making and product made. Applicant's argument is persuasive that the two groups are separate and distinct inventions related as process of making and product made instead of by the product and process of using rational. Applicant is thanked for their correction of the record in this regard and the examiner regrets the mistake.

However, applicant's argument that this variant relatedness results in the two groups avoiding a requirement for restriction is not found to be persuasive because the two groups are still not joined by a special technical feature as unity was properly broken in the 371 lack of unity requirement sent on 5/13/2009. Furthermore, the product can be made by a different process such as the one that is taught in the forthcoming art rejection below (Zhang et al.).

Also, following applicant's preliminary amendment to the claims, the examiner mischaracterized claim 30 as belonging to the same group of the other product claims, 26-29. Claim 30's amended recitation including method steps belongs in group I of the previous restriction requirement of 5/13/2009 and therefore herein will be unexamined as it is within the non-elected invention for further prosecution.

Claims 26-29 are pending herein. Claims 1-25 and 30 have been withdrawn as being drawn to non-elected subject matter.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claims 26-29 are objected to because of the following informalities: Claim 26 appears to depend from the non-elected method of group I. Appropriate correction is required.

Claim Interpretation

As to pending claims, 26-29 below, which contain intended use terms, the Examiner will interpret these claims in light of the structural elements that are disclosed and not for their intended use as stated after the phrase "obtainable by/from". The phrase, "obtainable by/from" is a product by process limitation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be made or employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Exparte Masham*, 2 USPQ2d 1647 (1987). The Examiner has applied references, which are capable of meeting these functions. A structure, which is capable of providing the intended use or a structure that is the same as the claimed product by process of making, is considered to meet the limitation of intended use recited in a claim to a device or an apparatus.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1797

1. Claims 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhang et al. (Analytica Chimica Acta 388 (1999) 71-78).

With regard to claim 26, Zhang et al. teach a functionalized inorganic-organic composite material derivated by sol-gel for construction of mediated amperometric hydrogen peroxide biosensor.

With regard to claim 27, Zhang et al. teach an electrically conductive substrate (See 2.3 preparation of modified electrode, pg. 73).

With regard to claim 28, while it is maintained that the limitations of a product by process claim are full met by minimally teaching the claimed structure, Zhang et al. teach a device where the sol-gel was obtained through a reaction comprising 3-Mercaptopropyltrimethoxysilane (MPTMS).

With regard to claim 29, a BAS100B/W potentiometer is taught (Pg. 72 right hand side).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally A. Sakelaris whose telephone number is 5712726297. The examiner can normally be reached on Monday-Friday 8-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 5712721267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. A. S./
Examiner, Art Unit 1797

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797